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In re Application of :
Laus et al :
Serial No. 09/461,684 : DECISION ON PETITION
Filed: December 14, 1999 :
Attorney Docket No. : 7636-002030 :

BACKGROUND

This application was filed on December 14, 1999, and contained, as filed, claims 1-18. On 27 March 2001 the examiner mailed to applicants a restriction requirement in which the claims were divided into 3 groups. Group I, claims 1-7 were drawn to an antigenic composition comprising an antigen having an added peptidic sequence. Group II, claims 8-14 were drawn to a therapeutic composition comprising a pulsed antigen presenting cell. Group III, claims 15-18 were drawn to a method of immunizing a subject against a tumor or pathogen using a pulsed antigen presenting cell.

On July 2, 2001 applicants elected without traverse Group I, claims 1 – 7 and cancelled non-elected claims 8-18.

On 08 March 2006 the examiner mailed to applicants a Notice of Allowability indicating that claims 1 and 5-7 were allowed.

On 06 June 2006 applicants filed a petition to withdraw the application from issue under 37 CFR 1.313(a). On 06 June 2006 applicants also submitted an amendment reintroducing cancelled nonelected claims 8-18 (original Groups II-III) as new claims 19-29, respectively, and cancelled elected product claims 2-3 (original Group I) as new claims 30-31, respectively.

DISCUSSION

The above prosecution history has been fully considered. The examiner has allowed Product claims 1 and 5-7. Applicants filed a petition requesting withdrawal from issue. Applicants stated in the petition that where a restriction was required between a product and a process of making and/or using the product, and the product was elected and subsequently found

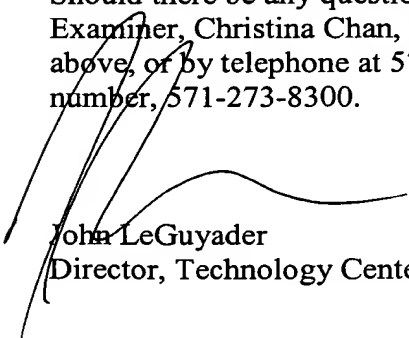
allowable, a claim to a nonelected invention might be rejoined under MPEP section 821.04. Applicants also stated that SEQ ID NO:2 is contained within SEQ ID NO:4, in searching SEQ ID NO:4, the examiner would have also searched SEQ ID NO:2. According to *In re Ochiai*, *In re Brouwer* and 35 U.S.C. section 103(b), 1184 O.G. 86 (March 26, 1996), withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. Here, the allowed claims 1 and 5-7 are drawn to an antigen composition comprising a protein antigen modified by chemical linkage or fusion to an added peptidic sequence consisting of SEQ ID NO:4. The newly introduced claims 19-25 (original Group II) are drawn to a therapeutic composition comprising a pulsed antigen presenting cell and the newly introduced claims 26-29 (original Group III) are drawn to a method of immunizing a subject using said pulsed antigen presenting cell. Clearly, the composition recited in claims 19-25 and the composition employed in the method recited in claims 26-29 are totally different from the composition recited in the allowed claims 1 and 5-7. As to newly submitted claims 30-31, SEQ ID NOS 1-7 are recited in claim 30 and a generic formula CYS-[X-Y-Y-Y-Y-Y]_n is recited in claim 31, whereas a specific SEQ ID NO: 4 is recited in the allowed claims 1 and 5-7. Therefore, the scope of the "added peptidic sequence" recited in new claims 30-31 is not commensurate with the peptidic sequence recited in the allowed claims 1 and 5-7. Further, in searching SEQ ID NO:4, the examiner would not have searched SEQ ID NO:2. SEQ ID NO:4 was searched under standard search parameters using the Smith-Waterman Algorithm that is based upon % query match. When such search is performed on the larger sequence, SEQ ID NO:4, and there is a disparity in length such as with the fragment of SEQ ID NO:4 that is SEQ ID NO:2, there is no guarantee that the search of SEQ ID NO:4 will reveal a hit on SEQ ID NO:2.

DECISION

Applicants have not shown good and sufficient reasons why withdrawal of the application from issue is necessary for the reasons set forth above. The Petition under 37 C.F.R. 1.313(a) requesting withdrawal from issue is **DENIED**.

It is noted that applicant has paid the issue fee and the Publication Division will issue the patent in due course.

Should there be any questions regarding this decision, please contact Supervisory Primary Examiner, Christina Chan, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0841 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John LeGuyader
Director, Technology Center 1600